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Company: USPTO GRP 2167 [EISA-101]  
From: R. Norris  
Re: SN 09/418,744  
Date: 07 Jan 2002

Number of pages being transmitted, including cover sheet: 9

Proposed discussion points for interview request.



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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Willard J. WEIBEL )  
Maria Elena LOPEZ ) Group No.: 2167  
John METSIG )  
Serial No.: 09/418,744 ) Examiner: E. Gort  
Filing Date: 15 October 1999 )  
Title: A METHOD FOR ELECTRONICALLY )  
MERGING DIGITIZED DATA SYSTEM OF )  
GENERATING BILLING STATEMENTS )  
FOR PUBLISHED ADVERTISING )

via facsimile

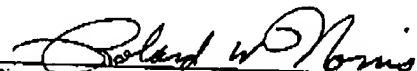
## PROPOSED DISCUSSION POINTS

Subsequent to the telephone conversation of 04 January 2002 between Examiner Gort and Applicants' undersigned attorney regarding the Final rejection of the above-identified case, dated 02 November 2001, the following Proposed items for discussion are presented to the Examiner per her request.

Applicant would seek to enter the below Proposed Amendments

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07 Jan 2002  
Date

  
Signature

EISA-101

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In the Specification:

page 2, line 7, before "periodicals" add --printed--.

page 3, line 3, after "advertisements" add --in print media--.

page 5, line 6, before "publication" add --printed--.

In the Claims:

Cancel Claims 1-7.

Amend Claims 8-9 and 15-20 as follows:

8. (Twice Amended) A method of constructing a billing statement for the printed publication of advertisements comprising:
- a. ~~a printed publication page containing a specific advertisement~~  
a. establishing a unique customer identifier for each customer;  
*associated with a network*
  - b. creating a first digital document representing [an] a print advertisement image, *which was previously run in printed periodical* with a unique print advertisement identifier and associating the unique customer identifier with the unique print advertisement identifier;  
*which is accessible by the customer*
  - c. creating a second digital document representing a print publication page image [with] containing the print advertisement image and associating the print publication page image with the unique print advertisement identifier;
  - d. creating a third digital document representing an invoice for print advertisements including specifying an identifier range for invoiced print advertisements;

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e. finding the first digital document by searching the unique customer identifier in a first database and copying the first digital document to an invoice database and listing each found first digital document as a line item on the invoice;

f. finding the second digital document and copying the second digital document to the invoice database; and

g. storing the first and second digital documents in a common file associated with the third digital document.

9. (Twice Amended) The method of claim 8 further including finding the second digital document by searching the unique print advertisement identifier.

15. (Twice Amended) A method of constructing a billing statement for [published] printed advertisements comprising:

a. establishing a unique customer identifier for a customer to be billed;

b. creating a digital billing invoice document and associating the digital billing invoice document with the unique customer identifier and storing the digital billing invoice document in an invoice file;

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- c. creating a digital print advertisement document with a unique advertisement identifier and associating the unique customer identifier with the unique advertisement identifier and storing the digital print advertisement document in an advertisement database;
- d. creating a digital print publication page, with the digital print advertisement document thereon, and having a unique page identifier; and associating the unique page identifier with the unique advertisement identifier and storing the digital print publication page document in a print publication page database;
- e. searching for digital print advertisement documents in the print advertisement database according to the customer identifier, identifying digital print advertisement documents according to the customer identifier, and copying identified digital print advertisement documents to the invoice file;
- f. searching for digital print publication pages associated with the digital print advertisement documents in the publication page database and copying the associated digital print publication pages to the invoice file; and
- g. cross referencing the billing invoice, print advertisement, and print publication page digital documents in the invoice file.

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16. (Twice Amended) The method of claim 15 including the further step of copying the billing invoice, print advertisement, and print publication page digital documents to a removable storage medium.

17. (Twice Amended) The method of claim 15 including the further step of listing each digital print advertisement document as a line item on the invoice document.

18. (Twice Amended) The method of claim 17 including the further step of displaying the billing invoice, print advertisement, and print publication page digital documents in human readable format.

19. (Twice Amended) The method of claim 17 wherein the step of creating the digital billing invoice document includes specifying an identifier range for the digital print advertisement documents.

20. (Twice Amended) The method of claim 19 wherein the step of specifying an identifier range further includes specifying a date range on which the digital print advertisement documents were published in print.

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Discussion Points

Will the Examiner allow the addition, by Amendment After Final Rejection, of the word "Print" to the present claims to clarify that the Applicant is teaching and claiming only within the realm of printed matter, such as periodicals and dailies (see e.g., page 2, line 7; page 5, lines 5-7)? And if so, will such amendment result in allowance of the claims over the cited references, which do not deal with printed publication advertisements and the traditional tearsheet billing methods therefor.

It was not Applicants' intent to infer or use the broad meaning of "publication", i.e. anything made public, when constructing the present application. It is believed that Applicant's disclosure, through exclusive reference to printed media such as newspapers and magazines was clearly limited to the more narrow meaning of "printed matter publicly distributed". It is thus believed that Applicant's disclosure inherently made clear that printed publications and their traditional tearsheet billing methods is the subject matter of the present invention. Applicant now merely seeks to amend the present application to explicitly make clear the subject matter of the present invention. It is believed that Applicant's disclosure presents and claims a novel technique unique to print publications for an arrangement of identifying both the printed advertisement copy and the printed publication page containing the advertisement copy in order to

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make either or both conveniently available to the advertiser in traditional, but electronic, tear sheet form.

It is further believed that the case of *In re Venner and Bowser*, 120 USPQ 192 (CCPA 1958), is not applicable to the present application because the claimed invention has a transformative effect on the nature of the material being manipulated, and the subsequent act of manipulation, when compared to the traditional tear-sheet methodology. It is further believed that the cited principle of the *In re Venner* case used by the Office is mere dicta to the case holding and is a generalization which is so over-broad as to be of extremely limited use and therefore should only be applied, if at all, to fact patterns which are substantially identical to the *In re Venner* case.



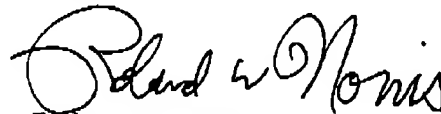
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### Conclusion

Applicants' undersigned attorney requests a telephone interview with the Examiner for discussion of the above points at her earliest convenience.

The undersigned can be reached at (847) 490-1400.

Respectfully submitted,



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